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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dov Moran

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01/26/2009

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UPPER MARLBORO, MD 20772

EXAMINER

TINKLER, MURIEL S

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

01/26/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/089,188	Applicant(s) MORAN ET AL.	
	Examiner MURIEL TINKLER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 18-41 and 43-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/6/2008, 9/29/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application has been reviewed. Currently: claims 1-50 are pending; claims 18-41 and 43-50 have been withdrawn; and claims 1-17 and 42 have been reviewed. The rejection(s) are as follows.

Response to Arguments

1. Applicant's arguments filed October 8, 2009 have been fully considered but they are not persuasive. The Applicant argues the Double Patenting rejection(s) of claims 1 and 42 are invalid; withdrawal of the 35 USC 102(b) rejection(s) based on Moran; and withdrawal of the 35 USC 103(a) rejection(s) based on Moran.
2. Regarding the Double Patenting Rejections.
 - a. In the reply filed on October 8, 2008 the Applicant states (on page 18) that: claim 14 of Moran '537 is distinct from claim 42 because Moran '537 includes the limitation that the at least one permission is one of a plurality of different permissions; and, claim 18 of Moran '380 is distinct from claim 42 because Moran '380 includes the limitation that the at least one associated type of permission is changeable and that the access control device has a single input. The Examiner asserts that because Moran teaching these additional limitations does not exclude it from reading on and substantially overlapping claim 42 to the point that it reads on every limitation of claim 42.
 - b. In the reply filed on October 8, 2008 the Applicant states (on page 20) that: Claim 1 is not obvious from either claim 11 of Moran '537 or claim 11 of

Moran '380, at least because claim 1 recites a flash memory controller for controlling the flash memory device. The Examiner asserts that: Moran '537 discloses this, see claim 1 (line 6-7), "an access control device (flash controller) for controlling access to said electronic data storage device"; and Moran '380 discloses this, see claim 1 (line 6-7), "an access control device (flash controller) for controlling access to said electronic data storage device".

c. The Applicant agreed, in the interview on April 14, 2008 that **a terminal disclaimer would overcome the Double Patenting rejections. The Examiner also agreed to withdraw the rejections if a properly filed terminal disclaimer was received.** However, there has been no terminal disclaimer filed as of January 18, 2009. Therefore, the Double Patenting rejections of claims 1 and 42 stand.

3. Regarding the 35 USC 102(b) and 25 USC 103(a) rejections. The Examiner agrees to withdraw the rejections with a properly filed terminal disclaimer. As of January 18, 2009, there has not been a filing of a terminal disclaimer, application data sheet, amendment or any other formal filing linking the Moran references to this application. **The Examiner will agree to withdraw the 102(b) and 35 USC 103(a) rejections over Moran '380 with a proper amendment to the specification, application data sheet and/or terminal disclaimer that links the Moran references to this application.**

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
5. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
6. Claim 42 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 14 of prior U.S. Patent No. 6,324,537 and claim 18 of prior U.S. Patent No. 6,539,3807. This is a double patenting rejection.
7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

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by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

9. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,324,573 and claim 11 of U.S. Patent No. 6,539,380. Although the conflicting claims are not identical, they are not patentably distinct from each other because they cover the same content.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-17 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Moran et al. (US 6,539,380), hereafter referred to as Moran.
13. Regarding claim 1: Moran discloses the same subject matter in claim 11.
14. Regarding claim 2: See the rejection of claim 1 above and claim 7 of Moran.
15. Regarding claim 3: See the rejection of claim 1 above and claim 14 of Moran.
16. Regarding claim 4: See the rejection of claim 3 above and claim 15 of Moran.
17. Regarding claim 5: See the rejection of claim 4 above and claim 16 of Moran.
18. Regarding claim 6: See the rejection of claim 5 above and claim 17 of Moran.
19. Regarding claim 42: Moran discloses duplicate wording to claim 18.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

22. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moran in view of Chang et al. (US 2003/0093812), hereafter referred to as Chang.

23. Regarding Claim 7: Moran discloses the information in claim 1. Moran does not specifically disclose the use of RAM. Chang teaches the use of RAM in paragraph 23. Therefore, it would be obvious to a person having ordinary skill in the art at the time the invention was made to include the use of RAM in the use of a computer system because it allows for the use of temporary memory.

24. Claims 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran as applied to claim 1 above, and further in view of Chang and Shamoon et al. (US 7,233,948), hereafter referred to as Shamoon.

25. Regarding claim 8: Moran discloses the information in claim 1. While Moran does disclose a chip in the Abstract, Moran does not specifically disclose the use of a cryptographic chip. Chang discloses the use of a cryptographic chip in paragraph 20 and 21. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Moran to include the use of cryptography on the chip because it would make the chip more secure. While Chang discloses that the chip decrypts data, Chang does not specifically disclose that the chip encrypts the data as well. Shamoon teaches the use of encrypting and decrypting data in paragraph 95, column 11 (lines 35-51). Therefore, it would have been obvious to a

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person having ordinary skill in the art at the time the invention was made to modify Moran and Chang to include both encryption and decryption because it would allow the user to read and write data more securely.

26. Regarding claim 9: Moran, Chang and Shamoon disclose the information in claim 8. Chang further discloses an authentication process in paragraph 23.

27. Regarding claim 10: Moran, Chang and Shamoon disclose the information in claim 8. Chang further discloses a chip emulating a smart card in the Abstract and paragraphs 3, 6, and 23.

28. Regarding claim 11: Moran, Chang and Shamoon disclose the information in claim 11. Chang further discloses storing data on an encrypted smart card in paragraph 23.

29. Regarding claim 12: Moran, Chang and Shamoon disclose the information in claim 8. Shamoon further discloses immediately performing encryption in paragraph 360, column 51 (lines 26-59).

30. Regarding claim 13: Moran, Chang and Shamoon disclose the information in claim 12. Shammon further discloses a cryptographic signature in paragraph 67, column 7 (lines 15-23).

31. Regarding claim 14: Moran, Chang and Shamoon disclose the information in claim 8. Chang further discloses cryptographic chip memory for storing a key in paragraph 23. Shamoon further discloses using removable memory in paragraph 249, column 33 (lines 18-34).

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32. Regarding claim 15: Moran, Chang and Shamoon disclose the information in claim 14. Chang further discloses storing encrypted data in chip memory in paragraphs 16 and 23.

33. Regarding claim 16: Moran, Chang and Shamoon disclose the information in claim 15. Chang further discloses that the cryptographic chip can be separate from the flash memory in paragraph 16.

34. Regarding claim 17: Moran, Chang and Shamoon disclose the information in claim 15. See the rejection of claim 1 above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is

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(571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691